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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,018	12/21/2000	Katsuyuki Matsumoto	001627	6673

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EXAMINER

PHAM, THOMAS K

ART UNIT	PAPER NUMBER
2121	

2121

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/741,018	Applicant(s) MATSUMOTO ET AL.	
	Examiner Thomas K Pham	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 23 June 2004.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-5 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-5 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a)  All    b)  Some \*    c)  None of:
      - 1.  Certified copies of the priority documents have been received.
      - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

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***Response to Amendment***

1. This action is in response to request for re-consideration filed on 6/23/2004.
2. Claims 1-5 have been considered but they are not persuasive.
3. Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,178,514 in view of "Universal Serial Bus Specification" Revision 1.0, January 15, 1996.
4. Applicant's arguments have been fully considered but they are not persuasive.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood U.S. Patent No. 6,178,514 in view of "Universal Serial Bus Specification" Revision 1.0, January 15, 1996 (hereinafter USB Spec).

**Regarding claim 1**

Wood teaches a portable electronic device comprising a common serial bus connector provided with data terminals and a power supply terminal in compliance with a common serial bus standard (col. 9 lines 39-41) for connecting a plurality of peripheral devices in common to a host information processing device (col. 9 lines 31-36), a common serial bus controller for executing predetermined data communication processing attendant on data communication with an

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information processing device connected to the common serial bus connector (fig. 12 element 224), and a control circuit connected to the common serial bus controller for executing device operation processing for the usual operation of the electronic device (fig. 7 element 21), the electronic device being capable of receiving a power supply from the information processing device or an external power source as connected to the common serial bus connector or from an internal power source (col. 9 lines 47-49 and col. 10 lines 10-13), the portable electronic device being characterized in that the control circuit discriminates among the sources of supply of power and causes the common serial bus controller to execute the predetermined data communication processing while power is supplied from the information processing device connected to the common serial bus connector, or executes the usual device operation processing while power is supplied from the external power source connected to the common serial bus connector (col. 9 lines 39-59) but does not teach power voltage is greater than or equal to 4.4 volts and is supplied from the information processing device connected to the common serial, or power voltage is less than 4.4 volts and is supplied from the external power source connected to the common serial bus connector. However, USB Spec teaches power voltage is greater than or equal to 4.4 volts and is supplied from a host device connected to the common serial bus connector (page 135, Section 7.2.2 third bullet, "All hubs and functions must be ... with this minimum voltage"). Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the voltage requirement of USB Spec to be part of the device of Wood in order to comply with the USB standard and specification.

**Regarding claim 2**

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Wood teaches a portable electronic device according to claim 1 wherein the control circuit comprises discriminating means for judging which of the information processing device and the external power source is connected to the common serial bus connector (col. 29 lines 4-8), and control means for causing the common serial bus controller to execute the predetermined data communication processing when the connection of the information processing device to the common serial bus connector is recognized (col. 22 lines 62-67), or executes the usual device operation processing when the connection of the external power source to the common serial bus connector is recognized (col. 30 lines 7-8).

**Regarding claim 3**

Wood teaches a portable electronic device according to claim 2 wherein the discriminating means identifies the source of supply of power based on the voltage value of the power supply terminal of the common serial bus connector (col. 28 lines 49-58).

**Regarding claim 4**

Wood teaches a portable electronic device according to claim 2 wherein the discriminating means identifies the source of supply of power depending on whether the common serial bus controller has started data communication via the common serial bus connector (col. 28 lines 24-27).

**Regarding claim 5**

Wood teaches a portable electronic device according to claim 2 wherein the control circuit further comprises means for detecting the connection of the information processing device or the external power source to the common serial bus connector based on the binary state of voltage

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level of the power supply terminal thereof, and the discriminating means identifies the source of supply of power according to the result of detection (col. 30 lines 7-18).

***Response to Arguments***

In the remark the applicant argues that cited reference fails to disclose:

I) “executing a usual device operation processing while power is supplied from an external power source connected to a common serial bus connector” as to claim 1

II) “power voltage is less than 4.4 volts and is supplied from the external power source connected to the common serial bus connector”

In response to applicant’s argument,

It is noted that applicants includes many conditions within the claim separated by “**or**” as follow:

**Limitation A:** control circuit connected to the common serial bus controller for executing device operation processing for the usual operation of the electronic device, the electronic device being capable of receiving a power supply from

- condition 1: the information processing device

**or**

- condition 2: an external power source as connected to the common serial bus connector

**or**

- condition 3: from an internal power source,

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**Limitation B**: the portable electronic device being characterized in that the control circuit discriminates among the sources of supply of power and causes the common serial bus controller to

- condition 1: execute the predetermined data communication processing while power voltage is greater than or equal to 4.4 volts and is supplied from the information processing device connected to the common serial bus connector,
- or**
- condition 2: executes the usual device operation processing while power voltage is less than 4.4 volts and is supplied from the external power source connected to the common serial bus connector.

Claim 1 is failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since the above limitations include multiple conditions (indefinite), Examiner should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. Ex parte Ionescu, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984). See MPEP 2143.03.

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**Response to Applicant Remarks:**

(I) Prior art (Wood) teaches (column 9 lines 61-62, “The USB standard supports to designations of USB devices 62, low power and high power”). Therefore, it is clear that USB standard provide at least an internal power source. Thus, limitation A, condition 3 is meet by the reference.

(II) Prior art “USB Specification” teaches (page 135, the third bullets “All hubs and functions must be able to provide configuration information with as little as 4.40 V at the connector end of their upstream cables”). Therefore, it is clear that USB standard supports voltages of greater than or equal to 4.4 volts. Thus, limitation B – condition 1 is meet by the reference.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 or the new number (571) 272-3689 beginning around mid. October 2004, Monday to Friday from 8:00 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179 (or 571 272-3687 starting around mid. Oct. 2004).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Thomas Pham**  
*Patent Examiner*

September 22, 2004



**Anthony Knight**  
**Supervisory Patent Examiner**  
**Group 3600**